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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER	
COLAIANNI, M	
ART UNIT	PAPER NUMBER
1731	8

DATE MAILED: 09/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/668,144	Williams
Examiner	**Art Unit**
Michael Colaianni	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Sep 25, 2000* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *29-61* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *29-61* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *4, 6*
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 29-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29, 31, 32, 39, 41-42, 46, 48-49, 55 and 57-58 use a percent comparison in claiming the amount of TSNA reduction. Specifically, these claims refer to the amount of TSNA reduction as being a percent "by weight lower thatn the content of said at least one tobacco-specific nitrosamine in cured brown tobacco made from the same tobacco crop but which is cured in the absence of steps designed to reduce the content of said at least one nitrosamine." This language is deemed indefinite because the claim compares a value achieved (the reduced TSNA tobacco value) with a speculative value (the value of the cured brown tobacco). The amount of TSNA is known to vary from leaf to leaf of tobacco, as well as between various parts of a single leaf. Thus, a claim calling for a comparison between an actual achieved value and a value that may or may not achieve a theoretical value is deemed to be indefinite.

Information Disclosure Statement

3. The information disclosure statement filed June 12, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

The "Other Documents" lacked a copy of the document "Tobacco Specific nitrosamines in some Nigerian Cigarettes". This reference was not considered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 29, 31-32, 39, 41-42, 44-46, 48-49, 55, 57-58, 60-61 rejected under 35 U.S.C. 102(b) as being anticipated by Azumano 3937227.

Azumano teaches drying at least a portion of the tobacco while in the tobacco is in an uncured and yellow (col. 10-11, lines 59-68, 1-5, 10-11); providing an air flow around the tobacco which is sufficient to substantially prevent an anaerobic condition (col. 10, lines 61-64); controlling at least one of humidity, temperature and airflow (col. 10, lines 61-67, the

"circulation" of air refers to the flow rate); and following the drying in the controlled environment the plant portion has a TSNA content of less than at least 75% by weight lower than the content of the TSNA content in cured brown tobacco from the same crop (col. 10-11, lines 61-67, 6-8; this is inherently taught by Azumano because the "aerobic" conditions (i.e. conditions permitting the respiration of the leaf) result in a cured leaf product that inherently must have a reduced TSNA value).

Azumano also inherently teaches that the TSNA values are dramatically reduced because Azumano teaches using the same method as applicant, namely an aerobic condition surrounding the uncured and yellow tobacco leaf during the curing process.

Azumano also teaches using a temperature of 100°F and 160°F (col. 10, lines 31-33, col. 11, lines 59-61).

6. Claims 30, 40, 47, 56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Azumano 3937227.

Azumano teaches applicant's claimed invention. See the §102(b) rejection above for Azumano's teachings. While it is believed that Azumano inherently teaches reducing the NNK level along with other TSNA's because Azumano practices the same method as applicant, in the alternative, it would have been prima facie obvious to reduce the NNK level because, as the Examiner takes Official Notice, NNK is deemed to be one of the worst TSNA's found in the tobacco. Thus, it would have been obvious to reduce or eliminate such a harmful TSNA as NNK.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 33-35, 43, 53-54, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Azumano 3937227 in view of Wilson 3664034.

Azumano teaches applicant's claimed invention. See the §102(b) rejection for Azumano's teachings. However, Azumano does not teach using a flue variety of tobacco, or the particular airflow rates.

However, Wilson teaches that it is well known to cure "bright varieties" of flue cured tobacco (col. 1, lines 6-8). Azumano teaches that any particular type of tobacco leaf may be used in their method (col. 1, lines 1-5, Azumano broadly teaches that "tobacco leaves" are cured). It

would have been obvious to use flue varieties with Azumano in order to cure more varieties of tobacco and thus increase the versatility of the method.

Moreover, Wilson teaches that it is known to use airflow rates of 50-120 cfm (col. 5, lines 23-29). Thus, it would have been obvious to use air flow rates of 70 cfm or 80 cfm because Wilson teachs that such air flow rates may be used. Also, using such air flow rates would ensure adequate air flow for enough oxygen for adequate respiration as taught by Azumano (col. 10, lines 61-64).

It would have been prima facie obvious at the time the invention was made to combine Wilson's teachings with Azumano's method of curing tobacco in order to provide the required oxygen concentration necessary for respiration of the tobacco and to increase the versatility of the method.

10. Claims 36-38, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Azumano 3937227 in view of Wilson 3503137.

Azumano teaches applicant's claimed invention. See the §102(b) rejection for Azumano's teachings. However, Azumano does not teach the various humidity levels in the controlled atmosphere.

However, Wilson teaches that any preselected humidity profile may be chosen for the curing process (col. 3, lines 36-40).

It would have been prima facie obvious at the time the invention was made to combine Wilson's teaching of using any particular humidity profile with Azumano's method of curing

tobacco in order to increase the versatility of the curing process and thus permit any variety of tobacco to be cured.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 29-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6202649. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims refer to reducing a TSNA while the application claims refer to specific TSNAs which are deemed to be obvious because the specific TSNAs claimed are well known in the tobacco are as being among the worst TSNAs. Thus, it would have been obvious to reduce such harmful TSNAs.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Colaianni whose telephone number is (703) 305-5493. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

MICHAEL COLAIANNI
PRIMARY EXAMINER

Art Unit 1731
September 12, 2001